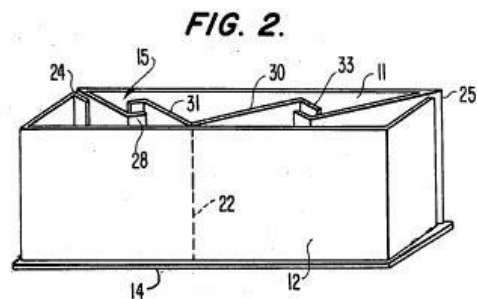


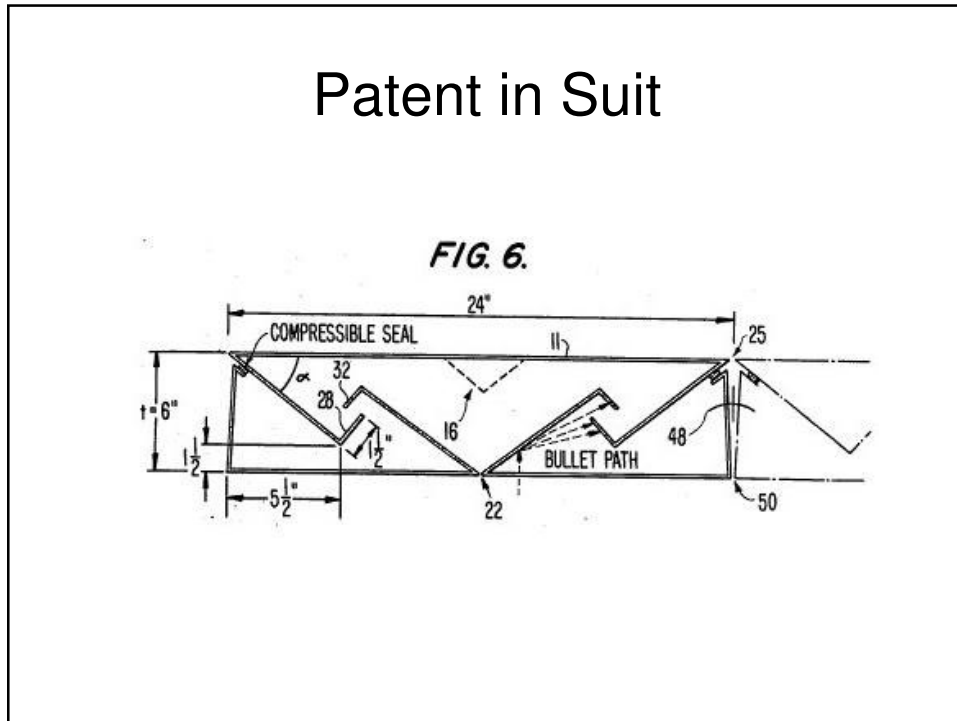
Patent Claim Construction:
Phillips v. AWH (Fed. Cir.,
July 12, 2005) (*en banc*)

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August 2005

Patent in Suit



Patent in Suit



Claim 1

- 1. Building modules adapted to fit together for construction of fire, sound and impact resistant security barriers and rooms for use in securing records and persons, comprising in combination,
 - an outer shell ...,
 - sealant means . . . and
 - further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.

Litigation History

District Court-1

- Parties stipulated to meaning of “baffle” as a “means for obstructing, impeding, or checking the flow of something.”
- D. Ct. concluded that “baffle” was ambiguous.
- D. Ct. interpreted the last claim element as "a means . . . for performing a specified function," subject to 35 USC §112, paragraph 6.
- D. Ct. found that "every textual reference in the Specification and its diagrams show baffle deployment at an angle other than 90 [degree] to the wall faces"

Litigation History

District Court-2

- Claim construction: the patented baffle must "extend inward from the steel shell walls at an oblique or acute angle to the wall face"
- Phillips could not prove infringement under that claim construction, so the district court granted summary judgment of noninfringement.

Litigation History

Court of Appeals Panel-1

- On appeal, *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004), the panel was divided as to the patent infringement claims.
- The majority (Lourie, Newman, JJ.) sustained the summary judgment of noninfringement, but on different grounds.
- The panel ruled that the baffle recital in the claim is not ruled by 35 USC §112, par. 6 because it recites sufficient structure.

Litigation History

Court of Appeals Panel-2

- The majority looked to the specification to understand the meaning of "baffle."
- It concluded that the patent uses "baffles" restrictively and excludes structures that extend at a 90 degree angle.
- The specification repeatedly refers to the ability of the claimed baffles to deflect projectiles and describes the baffles as being "disposed at such angles that bullets which might penetrate the outer steel panels are deflected."

Litigation History

Court of Appeals Panel-3

- The patent does not disclose a baffle a right angle to the wall, and baffles oriented at 90 degrees to the wall were found in the prior art.
- Even though claims were allowed with the non-restrictive term “baffle,” the majority said that the specification made clear that the invention involves baffles angled at other than 90 degrees.
- “It is in the interests of a sound patent systems and inventors, as well as the public, to hold inventors to their disclosures.” 363 F.3d at 1214.

Litigation History

Court of Appeals Panel-4

- Dissenting, J. Dyk noted that nothing in the specification redefines “baffles” or disclaims any scope from the ordinary meaning.
- impact resistance is just one of several objectives of the invention.
- no reason to alter the plain meaning of claim language with a limitation from the preferred embodiment.
- Favors a general purpose dictionary definition for “baffle.”
- Limiting the claims to the preferred embodiment contradicts a long line of precedent.

Questions for the *En Banc* Court



Litigation History

En Banc Question 1

- Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or by looking primarily to the patentee's use of the term in the specification?
- If both sources are to be consulted, in what order?

Litigation History

En Banc Question 2

- If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as his own lexicographer or when the specification reflects a clear disclaimer of claim scope?
- If so, what language in the specification will satisfy those conditions?
- What use should be made of general as opposed to technical dictionaries?
- How does the concept of ordinary meaning apply if there are multiple potentially applicable definitions for a term?
- Is it appropriate to look to the specification to determine what definition or definitions should apply?

Litigation History

En Banc Question 3

- If the primary source for claim construction should be the specification, what use should be made of dictionaries?
- Should the range of the ordinary meaning be limited to the scope of the invention disclosed in the specification, for example, when only a single embodiment is disclosed and no other indications of breadth are disclosed?

Litigation History

En Banc Question 4

- Instead of viewing the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches, should the two approaches be treated as *complementary methodologies* such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks?

Litigation History

En Banc Questions 5-6

- Question 5: When, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity under, *e.g.*, 35 U.S.C. §§102, 103, and 112?
- Question 6: What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of disputed claim terms?

Litigation History

En Banc Question 7

- Consistent with the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), and our *en banc* decision in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), is it appropriate for this court to accord any deference to any aspect of trial court claim construction rulings?
- If so, on what aspects, in what circumstances, and to what extent?

En Banc Ruling

Summary

- The *en banc* court agreed with the panel dissent that the claim should not be burdened with unclaimed features of the preferred embodiments, but disagreed that the claim construction should be based on general purpose dictionary definitions.
- Also agreed with the panel majority that the specification is a guide to claim interpretation, but disagreed that the specification here required a narrow construction of "baffle."
- Reversed panel ruling on meaning of "baffle" but did not adopt the D.Ct. ruling; remanded to D.Ct. for further proceedings.

En Banc Ruling

Summary-2

- Construe claims according to plain import.
- Seek meaning to person of ordinary skill in art.
- Use intrinsic evidence; dictionaries less important.
- Reaffirm principles of *Markman v. Westview Instruments* (Fed. Cir. *en banc*); *Vitronics v. Conceptronic*; and *Innova/Pure Water v. Safari Water Filtration Systems*.
- No ruling on the “deference” issue (Question 7).

En Banc Ruling

Not Means Plus Function Here

- Means+function rules apply only to purely functional limitations that do not recite the structure that performs the recited function.
- Claim recites structure (“means ... comprising baffles”). These are physical apparatus.
- agree with panel decision that D.Ct. erred by limiting the term to corresponding structures disclosed in the specification + equivalents.
- must next determine the correct construction of the structural term “baffles,” as used in the patent.

En Banc Ruling

Statutory Issue Re Section 112, Para. 1-2

- First 2 paragraphs of 35 U.S.C. §112 frame the claim interpretation issue.
- para. 1 states that the specification “shall contain a written description of the invention ...”
- para. 2 provides that the specification “shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”
- Main question: how much to rely on a patent specification to determine proper claim scope.

En Banc Ruling

Rely on Claims for Determining Scope

- The *claims* define the invention that the patentee is entitled to exclude others from practicing.
- “The written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims.” *Markman*, 52 F.3d at 980.

En Banc Ruling

Ordinary and Customary Meaning Prevails

- the words of a claim "are generally given their ordinary and customary meaning."
- the ordinary and customary meaning of a claim term is *the meaning the term would have to a person of ordinary skill in the art as of the effective filing date of the patent application.*

En Banc Ruling

Start With An Objective Baseline

- The way a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.
- Reason: inventors are typically persons skilled in the field of the invention, and patents are addressed to and intended to be read by others of skill in the pertinent art.

En Banc Ruling

Context

- the person of ordinary skill in the art is deemed to read the claim term in the context of ...
 - the particular claim containing the disputed term,
 - the entire patent, including the specification, and
 - the prosecution history.

En Banc Ruling

Usual Approach

- look to sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean.
 - *Note emphasis on PUBLIC availability*
- Those sources include the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.

En Banc Ruling
Context & Other Claims-1

- Consider the context of the surrounding words of the claim and the context in which a term is used in the asserted claim.
- Other claims of the patent in question, both asserted and unasserted, can be valuable sources as to claim term meaning.

En Banc Ruling
Context & Other Claims-2

- Differences among claims can be a useful guide in understanding the meaning of particular claim terms.
- *E.g.*, the presence of a dependent claim that adds a particular limitation raises a presumption that the limitation in question is not present in the independent claim.

En Banc Ruling
The Specification Is Primary

- A patent is a fully integrated written instrument.
- Must read claims in view of the specification, of which they are a part.
- The specification is always highly relevant and usually is dispositive; it is **the single best guide** to the meaning of a disputed term.
- Words of the claims must be based on the description. **The specification is the primary basis for construing the claims.**

En Banc Ruling
The Specification Is Primary-2

- Must interpret claims *in light of* the specification.
- Read both the claims and the specification with a view to ascertaining the invention.
- Claims must be *consistent with* the specification.
- Can interpret a claim term only with a full understanding of what the inventors *actually invented*.

En Banc Ruling

Special Meanings or Disclaimers in Spec'n.

- A special definition in the specification for a claim term, differing from the meaning it would otherwise have, will govern.
 - May define claim terms by implication.
- If the specification reveals an intentional disclaimer or disavowal of claim scope, the inventor's intention as expressed in the specification is regarded as dispositive.

En Banc Ruling

Using Spec'n. Comports with PTO Rules-1

- The PTO gives claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.
- PTO rules require application claims to conform to the invention as set forth in the remainder of the specification.

En Banc Ruling

Using Spec'n. Comports with PTO Rules-2

- Terms and phrases in the claims must find clear support or antecedent basis in the description so that their meaning may be ascertainable by reference to the description. *37 C.F.R. §1.75(d)(1)*.
- Hence it is proper for a court conducting claim construction to rely heavily on the written description for guidance as to the meaning of the claims.

En Banc Ruling

File History-1

- should also consider the prosecution history, if in evidence. This includes the cited prior art.
- the file history represents an ongoing negotiation between the PTO and the applicant. It is not the final product and often lacks the clarity of the specification and thus is less useful for claim construction purposes.

En Banc Ruling

File History-2

- The file history can show how the inventor understood the invention and whether the inventor limited the invention during prosecution.
- The purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution.

En Banc Ruling

Extrinsic Evidence - Generally

- district courts can rely on extrinsic evidence, *e.g.*:
 - evidence external to the patent and prosecution history
 - expert and inventor testimony
 - dictionaries
 - learned treatises
- *extrinsic evidence is less significant than the intrinsic record.*

En Banc Ruling

Extrinsic Evidence - Dictionaries

- dictionaries and treatises can be useful
- Technical dictionaries may help a court understand the underlying technology and the way one skilled in the art might use claim terms.
- dictionaries, especially technical ones, may be considered if the court deems them helpful in determining the true meaning of language used in the patent claims.

En Banc Ruling

Extrinsic Evidence – Expert Testimony

Expert testimony can be useful:

- to give background on the technology at issue,
- to explain how an invention works,
- to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or
- to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.

En Banc Ruling
Expert Testimony Limitations

- Experts' conclusory, unsupported assertions on the definition of a claim term are not useful.
- should discount expert testimony that is clearly at odds with the claim construction mandated by the written record of the patent

En Banc Ruling
Extrinsic Evidence – Reliability Issues-1

- Extrinsic evidence is less reliable for several reasons:
- not created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning.
- extrinsic publications may not be written by or for skilled artisans; may not reflect the understanding of a skilled artisan in the field.

En Banc Ruling

Extrinsic Evidence – Reliability Issues-2

- can be biased if generated for litigation.
- the expert may not be skilled in the relevant art.
- The expert's opinion may be offered in a form not subject to cross-examination.
- Only favorable extrinsic evidence will be presented.
- The public notice function of patents conflicts with undue reliance on extrinsic evidence.

En Banc Ruling

Extrinsic Evidence – Discretion of Court-1

- In sum, extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope *unless considered in the context of the intrinsic evidence.*
- extrinsic evidence can help educate the court regarding the field of the invention, and

En Banc Ruling

Extrinsic Evidence – Discretion of Court-2

- extrinsic evidence can help the court determine what a person of ordinary skill in the art would understand claim terms to mean.
- A district court in its sound discretion may admit and use such evidence.
- Must keep in mind the flaws inherent in each type of evidence and assess that evidence accordingly.

Dictionaries

A Closer Look



En Banc Ruling

Dictionaries Can Apply In Simple Cases

- In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.
- In such circumstances, general purpose dictionaries may be helpful.

En Banc Ruling

Clarification re Dictionaries-1

- *Texas Digital Systems v. Telegenix* referred to dictionaries, etc. as useful resources in determining the meaning of claim terms.
- *Texas Digital* stated that "the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning."

En Banc Ruling

Clarification re Dictionaries-2

- *Texas Digital* also said the presumption “will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”
- The *Texas Digital* approach “improperly restricts the role of the specification in claim construction.”

En Banc Ruling

Clarification re Dictionaries-3

- The dictionary focuses on the abstract meaning of words, not the meaning of claim terms within the context of the patent.
- Properly viewed, the "ordinary meaning" of a claim term is its meaning to the ordinary artisan after reading the entire patent.
- The inventor did not create the dictionary to describe the invention.
- Contrast between describing and claiming an invention and the objective of collecting all possible definitions for particular words.

En Banc Ruling

Clarification re Dictionaries-4

- “The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive.”
- “The risk of systematic overbreadth is greatly reduced if the court instead *focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history*, rather than starting with a broad definition and whittling it down.”

En Banc Ruling

Clarification re Dictionaries-5

- A dictionary may extend patent protection beyond proper coverage.
- Court has previously said that "a general-usage dictionary cannot overcome art-specific evidence of the meaning" of a claim term.
- An inventor can use a term differently in a patent than its use in technical dictionaries or treatises. Discrepancies are likely because a patent by its nature describes something novel.

En Banc Ruling

Clarification re Dictionaries-6

- dictionaries remain useful to assist in understanding the commonly understood meaning of words.
- dictionary definition is an unbiased source "accessible to the public in advance of litigation."
- As said in *Vitronics*, judges are free to consult dictionaries and technical treatises "at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents."

En Banc Ruling

Rules Going Forward-1

- Courts can construe terms without importing improper limitations by *keeping the focus on understanding how a person of ordinary skill in the art would understand the claim terms.*
- Courts should remember that the purposes of the specification are to *teach* and *enable* those of skill in the art to make and use the invention and to provide a *best mode* for doing so.

En Banc Ruling
Rules Going Forward-2

- Often, upon reading the specification in that context, it will become clear whether the patentee is setting out specific examples of the invention to accomplish those goals, or whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive.
- The manner in which the patentee uses a term within the specification and claims usually will make the distinction apparent.

En Banc Ruling
Rules Going Forward-3

- there is *no magic formula* for claim construction.
- The court is not barred from considering any particular sources or required to analyze sources in any specific sequence.
- Cannot contradict claim meaning that is unambiguous in light of the intrinsic evidence.
- *A judge might consult a general purpose or specialized dictionary to begin to understand the meaning of the term, before reviewing the remainder of the patent to determine how the patentee has used the term.*

En Banc Ruling
Rules Going Forward-4

- The *sequence of steps in consulting various sources is not important.*
- Must attach appropriate weight to those sources.
- *Vitronics* did not impose a rigid algorithm for claim construction, but simply attempted to explain why certain types of evidence are more valuable than others.
- Court reaffirms the approach to claim construction outlined in *Vitronics*, *Markman*, and *Innova*.

En Banc Ruling
Decision in Present Case

- The language of claim 1 ("further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls") imposes three clear requirements re the baffles.
 - made of steel;
 - part of load-bearing means for wall section;
 - pointed inward from the walls.

En Banc Ruling

Claim Differentiation in Present Case-1

- other claims of the patent specify specific functions served by the baffles.
- dependent claim 2 states that the baffles may be "oriented ... at angles for deflecting projectiles such as bullets ..."
- Putting this limitation on "baffles" in claim 2 makes it likely that the patentee did not contemplate that "baffles" already contained that limitation.

En Banc Ruling

Claim Differentiation in Present Case-2

- Independent claim 17 states the baffles are placed "projecting inwardly from the outer shell at angles tending to deflect projectiles that penetrate the outer shell."
- That limitation would be unnecessary if persons of skill in the art understood that the baffles inherently served such a function.

En Banc Ruling

Claim Differentiation in Present Case-3

- Dependent claim 6 provides another requirement for the baffles: they "... overlap and interlock at angles providing deflector panels extending from one end of the module to the other."
- If the baffles recited in claim 1 were inherently placed at specific angles, or interlocked to form an intermediate barrier, claim 6 would be redundant.

En Banc Ruling

Specification Must Enable All Claims-1

- Though the specification discusses bullet-deflecting, it does not imply that in order to qualify as baffles within the meaning of the claims, the internal support structures must serve the projectile-deflecting function in *all* the embodiments of all claims.

En Banc Ruling

Specification Must Enable All Claims-2

- The specification must teach and enable *all* the claims, and the section of the written description discussing the use of baffles to deflect projectiles serves that purpose for claims 2, 6, 17, and 23, which specifically claim baffles that deflect projectiles.
- The specification discusses several other purposes served by the baffles. For example, the baffles are described as providing structural support.

En Banc Ruling

Each Claim Need Not Meet All Objects-1

- “The fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives.” *Liebel-Flarsheim, 358 F.3d at 908*
- Although deflecting projectiles is one of the advantages of the baffles of the '798 patent, the patent does not require that the inward extending structures *always* be capable of performing that function.

En Banc Ruling

Each Claim Need Not Meet All Objects-2

- a person of skill in the art would not interpret the disclosure and claims to mean that a structure extending inward from one of the wall faces is a "baffle" if it is at an acute or obtuse angle, but is not a "baffle" if it is disposed at a right angle.

En Banc Ruling

Construe To Preserve Validity?-1

- The Court has acknowledged that claims should be construed to preserve validity but has not applied that principle broadly.
- Court has not made a validity analysis a regular component of claim construction.

En Banc Ruling
Construe To Preserve Validity?-2

- limited the maxim to cases in which "the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous."
- In such cases, consider whether the PTO would have issued an invalid patent, and whether the ambiguity in the claim should be resolved to preserve validity.

Dissent: Judge Lourie-1

- agreed with the court's opinion resolving the relative weights of specification and dictionaries in interpreting patent claims, in favor of the specification.
- The original panel decision implicitly decided the case based on the priorities that the *en banc* court has now reaffirmed.

Dissent: Judge Lourie-2

- The dissent from the panel decision relied on the "dictionaries first" procedure, which the court now has decided not to follow.
- no reason for the Court, having reaffirmed the principle on which the district judge and the panel originally decided the case, to send it back for further review.

Dissent: Judge Mayer

- Dissented from *Cybor en banc* ruling that claim construction is fully a matter of law.
- Would give deference to factual findings in claim construction.
- The Supreme Court did not suggest in affirming *Markman v. Westview Instruments (en banc)*, that claim construction is a purely legal question. It held only that, as a policy matter, the judge, as opposed to the jury, should determine the meaning of a patent claim.

Dissent – Judge Mayer

Inherently factual questions-1

- conflicting evidence re who qualifies as one of ordinary skill in the art
- the meaning of patent terms to that person
- the state of the art at the time of the invention
- contradictory dictionary definitions and which would be consulted by the skilled artisan

Dissent: Judge Mayer

Inherently factual questions-2

- the scope of specialized terms
- the problem a patent was solving
- what is related or pertinent art
- whether a construction was disallowed during prosecution
- how one of skill in the art would understand statements during prosecution, etc.

Dissent: Judge Mayer

- Questions underlying claim construction are factual and should be reviewed in accordance with Rule 52(a).
- A purely *de novo* review of claim interpretation cannot be reconciled with the Supreme Court's instructions regarding obviousness. While ultimately a question of law, obviousness depends on several underlying factual inquiries.
- Claim construction has many of the same questions.

Take Aways-1

- Unless Supreme Court says otherwise, claim construction is purely a legal issue.
- Federal Circuit will give plenary review to claim construction rulings by a district court.
- Rely first and foremost on claim language.
- Use proper context.
- Interpret consistently with specification.

Take Aways-2

- Watch for claim differentiation.
- Enforce special definitions and disclaimers in intrinsic documents.
- Objective is to determine the invention as claimed
- Dictionaries still useful, especially for simple issues

Take Aways-3

- Court disavows the method of using a dictionary and then looking for inconsistent statements in the intrinsic record
- Consider evidence re the understanding of a person of ordinary skill in the art as of the effective filing date
- Interpret a claim term “only ... with a full understanding of what the inventors actually invented and intended to ... claim”

Take Aways-4

- The construction that “stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.”
- Provide evidence to establish these “facts.”
 - *Is this opening the flood gates to expert testimony?*

Take Aways-5

- Subjective inventor testimony on what was intended to claim is heavily discounted.
- Evidence re understanding of person of skill in art as to claim meaning is central, but must be consistent with the patent document.
- *Query: how will this affect rendering opinions on claim interpretation?*

Further Background

- See Manzo *et al.*, *Federal Circuit Review of Markman Issues (2004)* at <http://iplac.org> (articles & resources page) (112 pp).